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Dated: August 12, 2004

Signature: _____

(Marcus J. Millet)

Docket No.: TESSERA 3.0-139 DIV
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas H. DiStefano

Application No.: 09/854,269

Filed: May 11, 2001

For: MICROELECTRONIC PACKAGES WITH
ELONGATED SOLDER
INTERCONNECTIONS

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: Group Art Unit: 2822
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: Examiner: M. Lewis
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MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMUNICATION

The present communication is responsive to the Official Action mailed June 16, 2004. A petition for a one-month extension of the term for response to said Official Action, to and including August 16, 2002, is transmitted herewith.

The sole requirement in the Official Action is a requirement for election of species. Applicant respectfully traverses such requirement as further set forth below. However, applicant elects the claims of "Embodiment I" namely, claims 1-3 for prosecution in the present application in the event that such requirement is not withdrawn.

It is respectfully submitted that a requirement for election of species is inappropriate because the asserted "species" set forth in the Official Action are not, in fact, separate, mutually exclusive species. As set forth in M.P.E.P. §§ 806.04(e) and 806.04(f), "species" are "always the specifically different embodiments" of an invention. "Claims are never species." A requirement for election of species is

proper only if "one claim recites limitations which under the disclosure are found in a first species but not in a second," whereas a second claim recites "limitations disclosed only for the second species and not the first." To use a humble analogy, tigers and elephants are species of the genus "mammal." Stripes and trunks are mutually exclusive features of the two species; stripes are found on the tiger but not on the elephant, whereas a trunk is found on the elephant but not on the tiger. In an application disclosing both tigers and elephants, election could properly be based on species defined by these features. However, "a trunk" and "a tail" are found in the same species (elephant); they are not mutually exclusive characteristics of the disclosed species and cannot form the basis for a requirement for election of species.

Here, the features used to define the "species" are all found in a single embodiment namely, the embodiment depicted in Fig. 14 and described in detail at paragraphs 0044 to 0045 of the specification. That embodiment includes the features referred to in the Official Action as "Embodiment I," namely, the contact pads (336, elongated solder columns (340'), microelectronic element (shown in breakaway partial view at the bottom of the drawing), flexible dielectric layer (polymer structure at the top of Fig. 14; numbered as "320" in Fig. 13) and terminals (the upwardly-facing surfaces of metallic elements 328). The same structure also includes the features of Embodiment II, namely, the confronting elements (the polymer element at the top and the microelectronic element at the bottom), pads (336 and 332), solder masses (340') and columnar inclusions (shown as lines within 340').


In short, the "species" are different features present in a single disclosed species. Accordingly, reconsideration and withdrawal of the requirement for election of species are

respectfully requested. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: August 12, 2004

Respectfully submitted,

By 

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